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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,315	08/30/1999	WILLIAM M. PARROTT	008193-20002	8973

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT

PAPER NUMBER

2143

20

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,315

Applicant(s)

PARROTT, WILLIAM M.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to the Amendment received on 06 May 2003.
2. Amendment C, Paper 19, received 06 May 2003 has been entered into record.
3. The application has been examined. Claims 1-23 are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. **Claims 1-2, 4-11, 13-14, 16, 17 and 22** are rejected under 35 U.S.C. 102(a) as being anticipated by Kobayashi UK Patent Application 234920.
6. Regarding **claim 1**, Kobayashi *teaches an adapter* (option apparatus page 1, lines 4-7 and page 2 line1, infrared type connection apparatus 1, see figure 2a & figure 5b, page 35, line 23-27 & page 36, line 1-5 portable phone antenna and base station), *comprising: an infrared transceiver* (Infrared Transmitter/Receiver circuit page 14, lines 12-15) *to transmit and receive information to and from an infrared data port* (page 35, lines 23-27); *a radio frequency transceiver* (Radio Transmitter/Receiver circuit page 12, lines 15-20) *to transmit and receive information to and from a radio frequency data system* (36, lines 1-4); *and a processor* (see control circuit page 13, line 5-6, page 15, lines 5-25 and page 35, lines 7-9) *coupled to the infrared transceiver and the radio frequency transceiver* (page 15, lines 18-25) *to convert information received from the infrared transceiver to a radio frequency format* (page 9, lines 8-

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11) *for transfer to the radio frequency data system and to convert information received from the radio frequency transceiver to an infrared format* (page 9, lines 8-13) *for transfer to the infrared data port*. By this rationale **claim 1** is rejected.

7. Regarding **claim 2**, Kobayashi further teaches *comprising a buffer* (see memory circuit page 13 line 15) *to provide temporary storage for information converted by the processor*. By this rationale **claim 2** is rejected.

8. Regarding **claim 4**, Kobayashi further teaches *wherein the infrared transceiver includes a driver circuit* (Transceiver/Receiver circuit page 14, lines 12-15) *to transmit information to the infrared data port*. By this rationale **claim 4** is rejected.

9. Regarding **claim 5**, Kobayashi further teaches *wherein the infrared transceiver includes a receiving circuit* (Transceiver/Receiver circuit page 12, lines 15-20) *to receive information from the infrared data port*. By this rationale **claim 5** is rejected.

10. Regarding **claim 6**, Kobayashi further teaches comprising a housing (page 22, lines 14-16 & see option apparatus for portable telephone Figure 5b). By this rationale **claim 6** is rejected.

11. Regarding **claim 7**, Kobayashi further teaches *a system* (see Figure 9, portable type computer, see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network), *comprising: a computing device including an infrared data port* (figure 9 infrared type connection apparatus 31), *the infrared port configured to send and receive information to a radio frequency data system* (page 35, lines 13-15), *the radio frequency data system* (page 35, lines 1-3) *in communication with the network and configured to send and receive information* (page 35, lines 15-17 & page 36 lines 4-8); *and an adapter to transfer information between the infrared data port and the radio frequency data system* (Figure 9 option

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apparatus for portable telephone 1), *the adapter including: an infrared transceiver to transmit and receive information to and from the infrared data port* (page 35, lines 23-27); *a radio frequency transceiver to transmit and receive information to and from the radio frequency data system* (page 36, lines 1-4); and a processor (see figure 3 control circuit CPU 120) *coupled to the infrared transceiver and the radio frequency transceiver* (figure 9 radio transmitter/receiver 11 and infrared transmitter/receiver 163) *to convert information received from the infrared transceiver to a radio frequency format* (page 9, lines 8-11) *for transfer to the radio frequency data system and to convert information received from the radio frequency transceiver to an infrared format* (page 9, lines 8-13) *for transfer to the infrared data port* (page 13, lines 7-13).

By this rationale **claim 7** is rejected.

12. Regarding **claim 8**, Kobayashi further teaches, *wherein the computing device is a portable computer* (see figure 9 portable type computer). By this rationale **claim 8** is rejected.

13. Regarding **claim 9**, Kobayashi further teaches *wherein the adapter physically connects to the computing device* (page 2, lines 21-23). By this rationale **claim 9** is rejected.

14. Regarding **claim 10**, Kobayashi further teaches *wherein the adapter is a stand-alone unit* (semi-fixedly inserted page 22, lines 14-16 & see option apparatus for portable telephone Figure 5b) *that communicates with the computing device* (see figure 4 portable telephone comprises control circuit 22 w/CPU 120) over an infrared communication link (see figure 5b infrared type connection apparatus 29 & 16). By this rationale **claim 10** is rejected.

15. Regarding **claim 11**, Kobayashi further teaches *wherein the adapter further comprises a buffer* (see memory circuit page 13, line 15) *to provide temporary storage for information converted by the processor*. By this rationale **claim 11** is rejected.

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16. Regarding **claim 13**, Kobayashi further teaches *wherein the infrared transceiver includes a driver circuit to transmit information to the infrared data port* (page 14, lines 12-15). By this rationale **claim 13** is rejected.

17. Regarding **claim 14**, Kobayashi further teaches *wherein the infrared transceiver includes a receiving circuit to receive information from the infrared data port* (page 12, lines 15-20). By this rationale **claim 14** is rejected.

18. Regarding **claim 16**, Kobayashi further teaches *a method for wirelessly connecting a computing device to a network* (see Figure 9 portable type computer & see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network), *comprising: receiving information over an infrared communication link from a remote computing device* (page 35, lines 18-23); *converting the information from an infrared format to a radio frequency format at a processor* (page 36, lines 1-4); *and communicating the information to the network over a radio frequency link* (page 36, lines 4-5). By this rationale **claim 16** is rejected.

19. Regarding **claim 17**, Kobayashi further teaches *receiving information over a radio frequency communication link from the network* (see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network); *converting the information from a radio frequency format to a infrared signal at a processor* [see rejection of claim 16, supra]; *and communicating the information to the computing device over an infrared communication link* [see rejection of claim 16, supra]. By this rationale **claim 17** is rejected.

20. Regarding **claim 22**, the limitations of this claim are substantially the same as that of claim 1, and are thus rejected for the same rationale in rejecting claim 1.

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Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claims 3, 12, 15, 18-21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi UK Patent Application 234920.

23. Regarding **claim 3**, Kobayashi teaches the invention as claimed as noted above.

Kobayashi does not explicitly teach the adapter further comprising a power supply in communication with the processor. Kobayashi teaches *the adapter (option apparatus) for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kobayashi to include a power supply because in order for the adapter to be electrically connected a power supply must be present. By this rationale **claim 3** is rejected.

24. Regarding **claim 12**, Kobayashi teaches the invention as claimed as noted above; However, Kobayashi does not explicitly teach, the adapter further *comprises a power supply coupled to the microprocessor*. Kobayashi teaches *the adapter (option apparatus) for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). By this rationale **claim 12** is rejected.

25. Regarding **claim 15**, Kobayashi teaches the invention substantially as claimed as noted above. Kobayashi does not teach a plurality of computing devices having infrared data ports, a

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plurality of infrared transceivers, and processing means in communication with the plurality of infrared transceivers and the radio frequency transceiver for converting information received from the plurality of infrared transceivers to a radio frequency format for transfer to the radio frequency data system and for converting information received from the radio frequency transceiver to an infrared format for transfer to at least one of the infrared data ports. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a plurality of computing devices having infrared data ports, a plurality of infrared transceivers, and a processing means in communication with said plurality of infrared transceivers because the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

26. Regarding **claim 18**, Kobayashi teaches the invention as claimed as noted above.

Kobayashi further teaches, wherein the radio frequency format conforms to Bluetooth protocol [page 36, line 1-5]. However, Kobayashi does not explicitly disclose radio frequency format conforms to Bluetooth. (The inclusion of radio frequency format that conforms to Bluetooth protocol would have been obvious to one of ordinary skill in the networking art at the time the invention was made in view of the notoriously widely known and widely implementation of radio frequency format conforming to Bluetooth protocol in the wireless and networking art.

The Examiner takes Official Notice (MPEP 2144.03) that “Bluetooth protocol is well known in the networking art at the time the invention was made as exemplified by several of the patents cited as relevant for this application (see Eichstaedt et al., U.S. Patent No. 6,218,958, Col. 1, lines 23-35 and Col. 3, lines 44-55). The Applicant is entitled to traverse the official notice according to MPEP 2144.03. However, MPEP 2144.03 further states “See also *In re Boon*, 439

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F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice).” Specifically, *In re Boon*, 169 USPQ 231, 234 states “as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed”. Further 37 CFR 1.671©(3) states “Judicial notice means official notice”. Thus, a traversal by the Applicant that is merely “a bald challenge, with nothing more” will be given little weight). And thus, since Kobayashi does provide motivation to utilize Bluetooth protocol through the use of a portable terminal unit, one of ordinary skill in the art would have provided provisions to utilize this protocol being that it is a standard for radio communication between electronic devices, developed and trademarked by the Bluetooth Consortium which allows for computer peripherals to communicate without cables, using radio frequencies for short-range exchange of data. For example, using your Bluetooth-equipped PC you could synchronize your telephone number list from your contact manager software with your Bluetooth-capable cell phone.

27. **Claims 19-20 and 23** contain similar limitations to the method claimed in claim 18, therefore claims 19-20 and 23 are rejected under the same rationale.

28. Regarding **claim 21**, Kobayashi further teaches wherein the adapter further comprises a buffer to provide temporary information storage [**memory circuit page 13 line 15**]. By this rationale **claim 21** is rejected.

Response to Arguments

29. Applicant's arguments filed on 06 May 2003 have been carefully considered but they are not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicants' main points of contention.

(A) Applicant contends that there is no disclosure or suggestion in Kobayashi of processor converting information received from the radio frequency transceiver to an infrared format.

30. As to "Point A", it is again the Examiner's position as stated in papers 11 and 18, that Kobayashi does in fact to this particular limitation as well as other claimed limitation. Specifically, with regards to Kobayashi teaching the conversion from IR to RF and RF to IR [page 9, lines 8-13]. Kobayashi further teaches a control circuit comprising a processor (CPU) [figure 3, control circuit 12]. This processor of the control circuit is shown to process signals between transceivers [page 13, lines 8-11] and convert signals into IR [page 35, lines 7-9]. Examiner would again like to also direct Applicant's attention to the portions of their specification (page 6, starting at line 7) that does not explicitly go into the actual details of how this conversion process takes place. The specification states that, "the IR to RF adapter (140) receives the information over an IR communication link, converts the information from an IR format to an RF format compatible with RF data system (130), and transfers the information to network 120 via RF data system (130)." Also, Applicant further implies that the conversion involves changing the communication protocol from an IR format to a RF format compatible with RF data system (see page 6, lines 25-32. Applicant also states that there is a program to do

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this conversion. Examiner would like to know where this program is within the specification. With regards to Kobayashi teaches that the radio transmitter/receiver circuit converts the transmission data into a radio signal by the antenna [see Kobayashi, pages 14 and 36]. Applicant also states on page 9, paragraph 1, that Kobayashi does not teach that these conversions are **fully** performed by the control circuit. Thus, by Applicant's own admission, conversion by the control circuit does take place. Applicant has not specified within the claim limitation nor has the examiner located within the disclosure that the conversion process must be fully performed by the control circuit. Also it is explicitly taught within Kobayashi that the entire system is controlled by the control circuit [see Kobayashi, page 13, lines 5-13]. Thus, inherently within Kobayashi, the controlled circuit is controlling any conversion that takes place.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.


WCV
Patent Examiner
Art Unit 2143
July 10, 2003


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100